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FISH & RICHARDSON PC 225 FRANKLIN ST BOSTON, MA 02110			ANANTHANARAYANAN, RAMYA	
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			2131	

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/902,309

Applicant(s)

KIKUTA ET AL.

Examiner

Ramya Ananthanarayanan

Art Unit

2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 2131

1. Claims 1-22 have been examined.

***Priority***

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed on record in the file.

***Information Disclosure Statement***

3. The information disclosure statements (IDSs) submitted on November 13, 2001 and July 12, 2004 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statements are being considered by the examiner.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 3, 6-12, 14, 17-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al (U. S. Patent No. 6651166) in view of Brown et al. (U. S. Patent Publication 20040139327).

6. Both Smith et al. and Brown et al. are analogous art because both are in the field of data authentication systems.

7. With respect to claims 1, 8 and 9, Smith et al. disclose an electronic notary system comprising a notary server and first terminal apparatus capable of performing network communication with said notary server,

Said first terminal including

Unique message generating means for generating message data unique to an electronic file designated by a user from the electronic file (Smith et al.: column 5, lines 7-8; column 4, lines 52-67),

Input means for inputting first user identification information for identifying the user (Smith et al.: column 5, lines 24-25), and

First terminal-side communication means for communicating with said notary server by establishing a communication link thereto by using second user identification information provided in advance from said notary server, receiving a registration key (Smith et al.: column 5, lines 28-53),

Said notary server including

First storage means for storing the first user identification information of the user and the second user identification information provided for the user in advance in correspondence with each other (Smith et al.: column 4, lines 37-40),

First communication means for communicating with said first terminal-side communication means by establishing a communication link thereto when the second user identification information sent from said first terminal-side

communication means coincides with the second user identification information stored in said first storage means (Smith et al.: column 5, lines 23-31),

Registration key generating means for generating a registration key upon reception of message data from said first terminal apparatus through said first communication means and transmitting the registration key to said first terminal apparatus through said first communication means (Smith et al.: column 5, lines 30-50), and

Recognition means for when the first user identification information received through said first communication means coincides with the first user identification information stored said first storage means (Smith et al.: column 5, lines 28-43).

8. Smith et al. do not disclose a second terminal apparatus, nor do Smith et al. disclose functionality of the notary server needed to communicate and process data from the second terminal apparatus. Additionally, Smith et al. do not disclose the transmission and receipt of message data and corresponding entities.

9. However, Brown et al. disclose an electronic notary system comprising a notary server and first and second terminal apparatuses capable of performing network communication with said notary server,

Said first terminal including

First terminal-side communication means for communicating with said notary server by establishing a communication link thereto by using second user identification information provided in advance from said notary server, transmitting at least the message data and first user identification information input from said input (Brown et al.: page 9, paragraph 0120, lines 4-9) to said notary server, and receiving a registration key (Brown et al.: page 6, paragraph 0089, lines 1-2),

Said notary server including

First communication means for communicating with said first terminal-side communication means by establishing a communication link (Brown et al.: Figure 5),

Second storage means for storing the message data received through said first communication means in correspondence with at least the registration key and date information (Brown et al.: page 7, paragraph 0102, lines 1-3),

Said second terminal apparatus including

Unique message generating means for generating message data unique to an electronic file from the electronic file (Brown et al.: page 5, paragraph 0071, lines 1-3, paragraph 0072; page 1, paragraph 0014, lines 3-7), and

Second terminal-side communication means for communicating with said notary server by establishing a communication link thereto, transmitting at least the message data and a registration key to said notary server (Brown et al.: page 9, paragraph 0120, lines 4-9; page 6, paragraph 0089, lines 4-6), and

Said notary server including

Second communication means for communicating with said second terminal-side communication means by establishing a communication link thereto (Brown et al.: Figure 5), and

Notary information generating means for, when the message data received through said second communication means coincides with message data stored in said second storage means and corresponding to a registration key received through said second communication means, generating notary information for certifying coincidence of the message data, and transmitting the notary information to said second terminal apparatus through said second communication means (Brown et al.: page 8, paragraphs 0110 and 0111).

10. It would have been obvious to one of ordinary skill in the art to combine the teachings of Brown et al. with the system of Smith et al. The motivation for such a combination would have been to allow more than one role or participant (Brown et al: page 3, paragraph 0039, lines 8-12) in the process of processing and notarizing an electronic document, and also to maintain information for auditing purposes (Brown et al: page 7, paragraph 102, lines 5-9).

11. With respect to claims 3, 10, and 11, Smith et al. disclose an electronic notary system comprising a notary server and first and second terminal apparatuses capable of performing network communication with said notary server,

Said first terminal apparatus including

Input means for inputting first user identification information for identifying the user (Smith et al.: column 5, lines 24-25), and

Transcript generating means for generating transcript information including an electronic file designated by the user (Smith et al.: column 5, lines 7-8; column 4, lines 52-67),

Said notary server including

First storage means for storing the first user identification information of the user and the second user identification information provided for the user advance in correspondence with each other (Smith et al.: column 4, lines 37-40),

First communication means for communicating with said first terminal-side communication means by establishing a communication link thereto when the second user identification information sent from said first terminal-side communication means coincides with the second user identification information stored in said first storage means (Smith et al.: column 5, lines 23-31),

Request key generating means for generating a request key in correspondence with the electronic file included in the transcript information received through said first communication means (Smith et al.: column 5, lines 30-50), and

Recognition means for when the first user identification information received through said first communication means coincides with the first user



identification information stored in said first storage means (Smith et al.: column 5, lines 28-43),

Said notary server including

Transcript file transmission control means for transmitting the electronic file to said second terminal apparatus through said second communication means (Smith et al.: column 7, lines 20-24).

12. Smith et al. do not disclose the second terminal apparatus, nor do Smith et al. disclose certain components of communication of the first terminal apparatus and the notary server.

13. However, Brown et al. disclose an electronic notary system comprising a notary server and first and second terminal apparatuses capable of performing network communication with said notary server,

Said first terminal apparatus including

First terminal-side communication means for communicating with said notary server by establishing a communication link thereto by using second user identification information provided in advance from said notary server, and transmitting at least the transcript information and first user identification information input from said input means to said notary server (Brown et al.: page 9, paragraph 0120, lines 4-9),

Said notary server including

Third storage means for storing the electronic file included in the transcript information as a transcript file in correspondence with at least the request key and date information (Brown et al.: page 7, paragraph 0102, lines 1-3),

Said second terminal apparatus including

Second terminal-side communication means for communicating with said notary server by establishing a communication link thereto (Brown et al: Figure 5), and

Transcript request means for generating transcript request information including a request key and transmitting the transcript request information to said notary server through said second terminal-side communication means (Brown et al.: page 5, paragraph 0071, lines 1-3, paragraph 0072; page 1, paragraph 0014, lines 3-7; page 9, paragraph 0120, lines 4-9; page 6, paragraph 0089, lines 4-6), and

Said notary server including

Second communication means for communicating with said second terminal-side communication means by establishing a communication link thereto (Brown et al.: Figure 5), and

Transcript file transmission control means for reading out an electronic file corresponding to the request key included in the transcript request information received through said second communication means from said third storage means (Brown et al: page 9, paragraph 0122, lines 1-3).

14. It would have been obvious to one of ordinary skill in the art to combine the teachings of Brown et al. with the system of Smith et al. The motivation for such a combination would have been to allow more than one role or participant (Brown et al: page 3, paragraph 0039, lines 8-12) in the process of processing and notarizing an electronic document, and also to maintain information for auditing purposes (Brown et al: page 7, paragraph 102, lines 5-9).

15. With respect to claims 6 and 7, Smith et al. do not disclose a system, wherein the first user identification information is biometric information of the user. However, Brown et al. disclose a system, wherein the first user identification information is biometric information of the user (Brown et al: page 6, paragraph 0086).

16. It would have been obvious to one of ordinary skill in the art to combine the teachings of Brown et al. with the system of Smith et al. The motivation for such a combination would have been to have even greater security (Brown et al: page 6, paragraph 0086).

17. With respect to claim 12, Smith et al. disclose an electronic notary method used for an electronic notary system including a notary server and first and second terminal apparatuses capable of performing network communication with the notary server, comprising:

The first storage step of causing the notary server to store first identification information of a user of the first terminal apparatus and second user identification information given to the user in advance in correspondence with each other (Smith et al.: column 4, lines 37-40);

The unique message generating step of causing the first terminal apparatus to generate message data unique to an electronic file designated by the user from the electronic file (Smith et al.: column 5, lines 7-8; column 4, lines 52-67);

The reception step of causing the first terminal apparatus to receive first user identification information for identifying the user (Smith et al.: column 5, lines 24-25);

The first communication link establishing step of causing the first terminal apparatus to transmit second user identification information, which is provided from the notary server in advance, to the notary server and establish the first communication link between the first terminal apparatus and the notary server when the second user identification information coincides with the second user identification information stored in the first storage step in the notary server (Smith et al.: column 5, lines 23-31);

The registration key generating step of causing the notary server to generate a registration key upon reception of the message data from the first terminal apparatus through the first communication link and transmit the registration key to the first terminal apparatus through the first communication link (Smith et al.: column 5, lines 30-50);

The second storage step of causing the notary server to store the message data received through the first communication link in correspondence with at least the registration key and date information when the first user identification information

Art Unit: 2131

received through the first communication link coincides with the first user identification information stored in the first storage step (Smith et al.: column 5, lines 28-43);

The unique message generating step of causing the second terminal apparatus to generate message data unique to an electronic file from the electronic file (Smith et al.: column 5, lines 7-8; column 4, lines 52-67).

18. Smith et al. do not disclose a notary registration step, a second communication link establishing step, a notarization request step, or a notary information generating step.

19. However, Brown et al. disclose an electronic notary method used for an electronic notary system including a notary server and first and second terminal apparatuses capable of performing network communication with the notary server, comprising:

The notary registration request step of causing the first terminal apparatus to transmit at least the message data generated in the unique message generating step and the first user identification information received in the reception step to the notary server through the first communication link (Brown et al.: page 9, paragraph 0120, lines 4-9);

The second communication link establishing step of causing the second terminal apparatus to perform communication by establishing a second communication link between the second terminal apparatus and the notary server (Brown et al: Figure 5);

The notarization request step of causing the second terminal apparatus to transmit at least the message data and a registration key to the notary server through the second

Art Unit: 2131

communication link (Brown et al.: page 9, paragraph 0120, lines 4-9; page 6, paragraph 0089, lines 4-6); and

The notary information generating step of causing the notary server to, when the message data received through the second communication link coincides with the message data stored in the second storage step and corresponding to the registration key received through the second communication link, generate notary information certifying the coincidence and transmit the notary information to the second terminal apparatus through the second communication link (Brown et al.: page 8, paragraphs 0110 and 0111).

20. It would have been obvious to one of ordinary skill in the art to combine the teachings of Brown et al. with the system of Smith et al. The motivation for such a combination would have been to allow more than one role or participant (Brown et al: page 3, paragraph 0039, lines 8-12) in the process of processing and notarizing an electronic document, and also to maintain information for auditing purposes (Brown et al: page 7, paragraph 102, lines 5-9).

21. With respect to claim 14, Smith et al. disclose an electronic notary method used for an electronic notary system including a notary server and first and second terminal apparatuses capable of performing network communication with the notary server, comprising:

The first storage step of causing the notary server to store first user identification information of a user of the first terminal apparatus in correspondence with second user identification information provided for the user in advance (Smith et al.: column 4, lines 37-40);

The reception step of causing the first terminal apparatus to receive first user identification information for identifying the user (Smith et al.: column 5, lines 24-25);

The transcript generating step of causing the first terminal apparatus to generate transcript information including an electronic file designated by a user (Smith et al.: column 5, lines 7-8; column 4, lines 52-67);

The request key generating step of causing the notary server to generate a request key upon receiving the transcript information from the first terminal apparatus through the first communication link (Smith et al.: column 5, lines 30-50);

Recognition means for the first user identification information received through said first communication means coincides with the first user identification information stored in said first storage means (Smith et al.: column 5, lines 28-43);

The transcript file transmission step of causing the notary server to transmit the electronic file to the second terminal apparatus through the second communication link (Smith et al.: column 7, lines 20-24).

22. Smith et al. do not disclose the first communication link establishing step, the transcript registration request step, the third storage step, the second communication link establishing step, the transcript request step, or the means to read an electronic file.

23. However, Brown et al. disclose an electronic notary method used for an electronic notary system including a notary server and first and second terminal apparatuses capable of performing network communication with the notary server, comprising:

The first communication link establishing step of causing the first terminal apparatus to transmit the second user identification information provided from the notary server in advance to the notary server and establish the first communication link between the first terminal apparatus and the notary server when the second user identification information coincides with the second user identification information stored in the first storage step in the notary server (Brown et al.: page 9, paragraph 0120, lines 4-9);

The transcript registration request step of causing the first terminal apparatus to transmit at least the transcript information generated in the transcript generating step and the first user identification information received in the reception step to the notary server through the first communication link (Brown et al.: page 9, paragraph 0120, lines 4-9);

The third storage step of causing the notary server to store the electronic file included in the transcript information as a transcript file in correspondence with at least the request key and date information (Brown et al.: page 7, paragraph 0102, lines 1-3);

The second communication link establishing step of performing communication by establishing a second communication link between the second terminal apparatus and the notary server (Brown et al: Figure 5);

The transcript request step of causing the second terminal apparatus to generate transcript request information included in a request key and transmit the transcript request



Art Unit: 2131

information to the notary server through said second communication link (Brown et al.: page 5, paragraph 0071, lines 1-3, paragraph 0072; page 1, paragraph 0014, lines 3-7; page 9, paragraph 0120, lines 4-9; page 6, paragraph 0089, lines 4-6); and

The transcript file transmission step of causing the notary server to read out an electronic file corresponding to the request key included in the transcript request information received through the second communication link from the information stored in the third storage step (Brown et al: page 9, paragraph 0122, lines 1-3).

24. It would have been obvious to one of ordinary skill in the art to combine the teachings of Brown et al. with the system of Smith et al. The motivation for such a combination would have been to allow more than one role or participant (Brown et al: page 3, paragraph 0039, lines 8-12) in the process of processing and notarizing an electronic document, and also to maintain information for auditing purposes (Brown et al: page 7, paragraph 102, lines 5-9).

25. With respect to claims 17 and 18, Smith et al. do not disclose a system wherein the first user identification information of the user is biometric information. However, Brown et al. disclose a method, wherein the first user identification information is biometric information of the user (Brown et al: page 6, paragraph 0086).

26. Please refer above for the motivational benefits with regards to the application of the teachings of Brown et al. to the teachings of Smith et al.

27. With respect to claims 19 and 21, Smith et al. disclose a system, wherein

Said system further comprises a Web server which is located on the network and has a Web site from which the request key can be acquired (Smith et al.: column 7, lines 31-48), and

Said notary server comprises URL information notification means for transmitting by electronic mail URL information of the Web site to an electronic mail address designated by said first terminal apparatus (Smith et al.: column 5, lines 57-58; column 7, lines 37-48).

28. With respect to claims 20 and 22, Smith et al. do not disclose forth storage means for the system. However, Brown et al. have disclosed a system, wherein said system further comprises fourth storage means for, when said transcript file transmission control means transmits an electronic file to said second terminal apparatus, storing at least one of a time when transcript request information is received from said second terminal apparatus and a time when the electronic file is transmitted to said second terminal apparatus (Brown et al.: page 7, paragraph 0102, lines 1-3).

29. It would have been obvious to one of ordinary skill in the art to combine the teachings of Brown et al. with the system of Smith et al. The motivation for such a combination would have been to maintain information for auditing purposes (page 7, paragraph 102, lines 5-9).

Art Unit: 2131

30. Claims 2, 4, 5, 13, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al (U. S. Patent No. 6651166) and Brown et al. (U. S. Patent Publication 20040139327) as applied to claims 1 and 12, and further in view of Bisbee et al. (U. S. Patent 6,237,096).

31. Smith et al., Brown et al., and Bisbee et al. are all analogous art because all are in the field of data authentication systems.

32. With respect to claim 2, Smith et al. disclose a system, wherein

Said notary server comprises recognition means for when first user identification information received through said first communication means coincides with the first user identification information stored in said first storage means (Smith et al.: column 5, lines 28-43),

Said notary server comprises transcript file transmission control means for transmitting the electronic file to said second terminal apparatus through said second communication means (Smith et al: column 7, lines 20-24).

33. Brown et al. disclose a system, wherein

Said notary server comprises transcript file transmission control means for reading out an electronic file corresponding to the request key included in the transcript request information received through said second communication means from said third storage means (Brown et al: page 9, paragraph 0122, lines 1-3).

Art Unit: 2131

34. The combination of Smith et al. and Brown et al. do not disclose either a first or second terminal apparatus, nor do the combination of Smith et al. and Brown et al. disclose storage means.

35. Bisbee et al. disclose a system, wherein

Said first terminal apparatus comprises transcript generating means for generating transcript information by integrating an electronic file designated by a user, message data generated on the basis of the electronic file, and a registration key corresponding to the electronic file, and transmitting the transcript information to said notary server through said first terminal-side communication means (Bisbee et al.: column 7, lines 13-18; column 3, lines 9-19; column 10, lines 59-61),

Said notary server comprises

Request key generating means for generating a request key in correspondence with information included in the transcript information received through said first communication means (Bisbee et al.: column 8, lines 15-21), and

Third storage means for storing the electronic file included in the transcript information as a transcript file in correspondence with the request key when the message data included in the transcript information received through said first communication means coincides with message data stored in said second storage means and corresponding to the registration key included in the transcript information (Bisbee et al: column 11, lines 13-42; column 7: lines 13-19),

Art Unit: 2131

Said second terminal apparatus comprises transcript request means for generating transcript request information including a request key and transmitting the transcript request information to said notary server through said second terminal-side communication means (Bisbee et al: column 13, lines 1-7).

36. Please refer above for the motivational benefits with regards to the application of the teachings of Brown et al. to the teachings of Smith et al.

37. It would have been obvious to one of ordinary skill in the art to combine the teachings of Bisbee et al. with the combined system of Smith et al. and Brown et al. The motivation for such a combination would have been to provide paperless commercial transactions and eliminate the need for hard copies of original documents and the resources necessary for hard copy document storage. Additionally, such a combination would facilitate easy retrieval of an authenticated document by many different authorized parties (Bisbee et al.: Abstract).

38. With respect to claims 4 and 15, Smith et al. disclose a system, wherein

Said system further comprises a Web server which is located on the network and has a Web site from which the request key can be acquired (Smith et al.: column 7, lines 31-48), and

Said notary server comprises URL information notification means for transmitting by electronic mail URL information of the Web site to an electronic mail address

Art Unit: 2131

designated by said first terminal apparatus (Smith et al.: column 5, lines 57-58; column 7, lines 37-48).

39. With respect to claim 5, Smith et al. do not disclose a system, wherein said system further comprises fourth storage means. However, Brown et al. disclose a system, wherein said system further comprises fourth storage means for, when said transcript file transmission control means transmits an electronic file to said second terminal apparatus, storing at least one of a time when transcript request information is received from said second terminal apparatus and a time when the electronic file is transmitted to said second terminal apparatus (Brown et al.: page 7, paragraph 0102, lines 1-3).

40. Please refer above for the motivational benefits with regards to the application of the teachings of Brown et al. to the teachings of Smith et al.

41. With respect to claim 13, Smith et al. disclose a method, wherein said method further comprises:

Recognition means for when first user identification information received through the first communication link coincides with the first user identification information stored in the first storage step (Smith et al.: column 5, lines 28-43);

The transcript file transmission step of causing the notary server to transmit the electronic file to the second terminal apparatus (Smith et al: column 7, lines 20-24).

Art Unit: 2131

42. Brown et al. disclose a method, wherein said method further comprises:

The transcript file transmission step of causing the notary sever to read out the electronic file corresponding to the request key included in the transcript request information received by the second terminal apparatus from the information stored in the third storage step (Brown et al: page 9, paragraph 0122, lines 1-3).

43. The culmination of Smith et al. and Brown et al. do not disclose transcript generation, key generation, or storage means in the notary server.

44. Bisbee et al. disclose a method, wherein said method further comprises:

The transcript generating step of causing the first terminal apparatus to generate transcript information by integrating an electronic file designated by a user, message data generated on the basis of the electronic file, and a registration key corresponding to the electronic file and transmit the transcript information to the notary server through the first communication link (Bisbee et al.: column 7, lines 13-18; column 3, lines 9-19; column 10, lines 59-61);

The request key generating step of causing the notary server to generate a request key in correspondence with information included in the transcript information received through the first communication link (Bisbee et al.: column 8, lines 15-21);

The third storage step of causing the notary server to store an electronic file included in the transcript information corresponding to the request key when the message data included in the transcript information received through the first communication link

Art Unit: 2131

coincides with the message data stored in the second storage step and corresponding to the registration key included in the transcript information (Bisbee et al: column 11, lines 13-42; column 7: lines 13-19);

The transcript request step of causing the second terminal apparatus to generate transcript request information included in the request key and transmit the transcript request information to the notary server (Bisbee et al: column 13, lines 1-7).

45. Please refer above for the motivational benefits with regards to both the application of the teachings of Brown et al. to the teachings of Smith et al., and the application of the teachings of Bisbee et al. to the combined teachings of Smith et al. and Brown et al.

46. With respect to claim 16, Smith et al. do not disclose a method, wherein said method further comprises a fourth storage step. Brown et al. disclose a method wherein said method further comprises the fourth storage step of, when an electronic file is transmitted to the second terminal apparatus in the transcript file transmission step, storing at least one of a time when transcript request information is received from the second terminal apparatus and a time when the electronic file is transmitted to the second terminal apparatus. (Brown et al.: page 7, paragraph 0102, lines 1-3).

47. Please refer above for the motivational benefits with regards to the application of the teachings of Brown et al. to the teachings of Smith et al.



Art Unit: 2131

*Conclusion*


48. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: U.S. Publication 2002/0129238, Toh et al. "Secure and Reliable Document Delivery Using Routing Lists".

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramya Ananthanarayanan whose telephone number is (571) 272-5860. The examiner can normally be reached on Monday through Friday, 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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